

**PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Gray, et al.
Serial No: 10/611,455
Filing Date: June 30, 2003
Confirm No: 1612

Examiner: Ingvaldstad, Bennett
Art Group: 2623
Docket No: ATT030076

Title: System and Method for Message Notification

Date: 7/22/2008

Honorable Commissioner of
Patents and Trademarks,
Alexandria, Virginia 22313

Pre-Appeal Brief Request for Review

1. In the Office Action mailed 5/13/2008, the Examiner rejected claims 1-3, 5-14, 16-24 and 26-31 under 35 USC § 103 (a) as being unpatentable over Nakano (U.S. Publication No. 2002/0147988) in view of Grzeczowski (U.S. Publication No. 2004/0049785); and claims 4, 15 and 25 under 35 USC § 103 (a) as being unpatentable over Nakano (U.S. Publication No. 2002/0147988) in view of Grzeczowski (U.S. Publication No. 2004/0049785) and further in view of Chatfield (U.S. Publication No. 2002/0138561). In the Advisory Action dated 6/26/2008, the Examiner indicated that Applicant's arguments after final were considered but did not place the application in a condition for allowance. Applicant respectfully submits that there is a clear deficiency in the prima facie case in support of this rejection and requests review of the allowability of claims 1-31 pursuant to the Pre-Appeal Brief Pilot Program.

2. As discussed above, claim 1 was rejected under 35 USC § 103 (a) as being unpatentable over Nakano (U.S. Publication No. 2002/0147988) in view of Grzeczowski (U.S. Publication No. 2004/0049785). The applicant respectfully disagrees with the present rejection because this combination is improper and/or fails to disclose the present invention. Claim 1 recites in part:

(1) determining whether to inform a user of an interactive television service of receipt of an email message, the determining made independent of any query by the user of any email server or email account;

(2) responsive to determining to inform the user of the receipt of the email message, generating a hot key signal indicating availability of the email message; and

(3) inserting the hot key signal into a content signal transmitted to the user from an interactive television service provider via a network with which the user and the interactive television service provider are connected,

(4) whereby inserting the hot key signal into the content signal comprises multiplexing the hot key signal with the content signal and modulating the multiplexed signal for delivery to the user. [numerals and emphasis added]

In setting forth the basis for the rejection, the Examiner cites Nakano for “determining made independent of any query by the user of any email server or email account” and Grzeczowski for “multiplexing the hot key signal with the content signal and modulating the multiplexed signal for delivery to the user”. However, Applicant respectfully asserts that this combination of Nakano and Grzeczowski is improper.

Nakano states as follows,

[0014] To achieve these stated and other objects, the present invention is embodied and described as a software application residing on a STB which queries an e-mail server and notifies a user that an e-mail message fulfilling specific filter criteria has arrived. In a preferred embodiment, the e-mail filtering and notification application resides on a Set Top Box (STB) which is connected between a TV content provider, an Internet provider having an e-mail server, and a TV; a software program resident on the STB which allows a user to specify e-mail filter criteria and notification icons which then retain and store those criteria and icons. The software program preferably includes a querying module which queries the e-mail server to determine whether e-mail fulfilling the user-specified criteria has arrived at the e-mail server, and upon arrival of an e-mail fulfilling the criteria, the application notifies the user by posting the notification icons to the STB. [emphasis added]

Therefore, in this combination, the set-top box queries the email server in part (1) at the user’s location. In part (2) a hot key signal is generated indicating availability of the email message. However, in part (3), the hot key signal is inserted into a content signal transmitted to the user from an interactive television service provider via a network with

which the user and the interactive television service provider are connected. Applicant respectfully asserts that Nakano teaches away from this combination.

A. There would be no need to insert a hot key signal indicating availability of the email message in a content signal transmitted to the user from an interactive television service provider via a network. The set-top box at the user's location already has the notification.

B. The interactive television service provider has to have the hot key signal in order to insert it. There is no teaching in Nakano or Grzeczkowski of sending either a hot key signal from the user's location (where it resides in Nakano) to the interactive television service provider so that a hot key signal can be then inserted by the interactive television service provider (Grzeczkowski) as recited in claim 1.

For these reasons, claim 1 and claims 2-5 that depend therefrom, are patentably distinct from the prior art.

In addition, the combination of Nakano and Grzeczkowski does not meet each element of the claimed invention. Neither Nakano nor Grzeczkowski teach inserting a hot key signal indicating availability of the email message into a content signal transmitted to the user from an interactive television service provider via a network. For this additional reason, claim 1 and claims 2-5 that depend therefrom, are patentably distinct from the prior art.

3. As discussed above, claims 6, 11, 17, 22 and 27 were also rejected under 35 USC § 103 (a) as being unpatentable over Nakano (U.S. Publication No. 2002/0147988) in view of Grzeczkowski (U.S. Publication No. 2004/0049785). As discussed in conjunction with claim 1, the combination of Nakano and Grzeczkowski is improper. In fact, Nakano teaches away from this combination. For this reason, claims 6, 11, 17, 22 and 27 and claims 7-10, 12-16, 18-21, 23-26 and 28-31 that depend therefrom, are patentably distinct from the prior art.

The Examiner is invited to contact the undersigned by telephone or facsimile if the Examiner believes that such a communication would advance the prosecution of the present invention.

RESPECTFULLY SUBMITTED,

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

ATT030076

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Typed or printed name

Application Number

10/611,455

Filed

06/30/2003

First Named Inventor

James Harold Gray

Art Unit

2623

Examiner

Ingvoldstad, Bennett

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)☒ attorney or agent of record.
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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

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